

Remarks

The present application has been reviewed in light of the Office Action dated April 23, 2008. By the foregoing amendments claim 16 is amended, and accordingly, claims 1-3, 6-7, 9-14 and 16-21 are pending after the amendments. Applicants respectfully submit that no new matter is added by the amendments.

Discussion of Claims 1-3, 6, 7, 9-14 and 20-21

Claims 1-3, 6, 7, 9-14 and 20-21 are again rejected under 35 U.S.C. 103(a) as being obvious over Prabhu et al. (US 7,019,778) in view of **Asada** (US 2003/0030732) and Hatanaka (US 6,438,320).

As previously presented in Applicants' Response dated February 1, 2008, Applicant respectfully resubmits that the above-stated rejection of claims 1-3, 6, 7, 9-14 and 20-21 is improper at least for the reason that **Asada** (US 2003/0030732) is not a valid prior art reference under 35 U.S.C. 102(e) to be cited to reject the present invention because the effective date (i.e., the U.S. filing date) of the Asada reference is later than the effective date, namely, the foreign priority date, of the present invention for the 102(e) consideration. For further details, please refer to Applicants' Response of February 1, 2008.

In the present Office Action, the Examiner has noted that Applicant cannot rely on the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with CFR 1.55. Applicants enclose hereto an English translation of the Korean priority application (KR 2002-40972) along with a signed statement certifying the accuracy of the English translation.

Accordingly, Applicants respectfully submit that Asada is not a valid prior art reference to reject the claims under 35 U.S.C. 102(e) or 102(b). Therefore, the

rejection of claims 1-3, 6, 7, 9-14 and 20-21 under 35 U.S.C. 103(a) is improper and should be withdrawn at least under this reason.

Moreover, further details of patentability of the claims are discussed herein. As specifically recited in independent claims 1 and 20, **claims 1-3, 6, 7, 9-14 and 20-21 each** requires, among others, the limitation of: the menu option and the user input unit further enabling the user to record a sound, the sound recorded being stored in the rewritable memory (or the flash memory with regard to claims 20-21), and further enabling the user to select the sound recorded as the start sound of the camera.

Applicant respectfully submits that none of the cited references of record teaches, among others limitations, at least the above-identified limitation of the invention as claimed in claims 1-3, 6, 7, 9-14 and 20-21.

Prabhu et al., the primary reference of the rejection, discloses a method for customizing a digital camera for at least one particular user. However, as detailed below, Prabhu et al. fails to disclose or teach the required feature that the menu option and the user input unit further enable the user to record a sound, the sound recorded being stored in the rewritable memory, and further enable the user to select the sound recorded as the start sound of the camera.

More specifically, Prabhu et al. fails to teach the use of the menu option and the user input unit that enables the user to record a sound which is subsequently stored in the rewritable memory (or the flash memory in claims 20-21) for use as the start information signal, and that the menu option and the user input unit further enables the user to select the sound recorded as the start sound of the camera. There is not any disclosure in the Prabhu et al. that teaches a desired sound is to be recorded by the user selection and the recorded sound is then stored in a rewritable memory of the camera for later selection (via the use of the menu option and the user

input unit) as the start sound of the camera at starts up of the camera, as is required by the claimed invention. The Prabhu et al. disclosure is entirely ignorant of this claimed feature. In addition, Applicant further notes that the Examiner has also acknowledged that Prabhu et al. fails to disclose this claim limitation. See Office Action at Page 8, first paragraph.

Applicant submits that none of other prior art references of record, including Hatanaka (US 6,438,320), discloses or teaches this claim limitation, namely, the use of the menu option and the user input unit that enables the user to record a sound which is subsequently stored in the rewritable memory for use as the start information signal, and that further enables the user to select the sound recorded as the start sound of the camera.

Hatanaka discloses a file management system for managing data of photographed images of an electronic camera, in which the camera may include a recording unit 32 for recording an audio sound which is to be subsequently stored in an auxiliary storage device 33. See FIG. 3.

However, Hatanaka does not disclose any start information signal setting features of the camera as claimed in the present invention. Hatanaka is entirely ignorant of the start information setting features of the claims that the sound recorded and stored in the rewritable memory of the camera is be selected by the user (via the use of the menu option and the user input unit) as the start sound of the camera at starts up of the camera. Accordingly, similar to Prabhu et al. discussed above, Hatanaka also fails to disclose or teach the above-identified claimed feature that the menu option and the user input unit further enable the user to record a sound, the sound recorded being stored in the rewritable memory, and the menu option and the user input unit further enable the user to select the sound recorded as the start sound of the camera.

Accordingly, Prabhu et al. and other references of record (including Hatanaka) fail to disclose or teach, among others, the above-identified limitations of the claimed invention. In view of the foregoing, claims 1-3, 6-7, and 9-14 and 20-21 are patentable over the references of record under 35 U.S.C. 103(a).

In rejecting independent claim 1, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of invention to have been motivated to modify Prabhu et al. in view of Asada (which is not valid prior art as discussed above) and Hatanaka to have a start image and a start sound to be selected from information stored in the rewritable memory of the camera, the menu option and the user input unit further enabling the user to record a sound with a recording unit, the sound recorded being stored in the rewritable memory, and further enabling the user to select the sound recorded as the start sound of the camera, in order to allow the user to further customize the camera to his or her liking, making its use more enjoyable. Office Action, page 8, line 17 to page 9, line 3.

Applicant respectfully traverses and submits that this allegation might have been based on the impermissible hindsight analysis utilizing the claims of the invention as a guide, and thus, is contrary to the well established patent law. It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the modification or combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

In the present case, each of the Prabhu et al. reference and Hatanak reference fails to disclose or teach the above-identified limitations of the claims. Moreover, none of the references provides any suggestion with respect to the desirability of the modification or combination. Accordingly, Applicant respectfully submits that there is absolutely no motivation provided in either of the references of record to make the

modifications necessary to reaching the missing gaps and to arrive at the claimed invention.

Discussion of Claims 16-19

Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Prabhu et al. (US 7,019,778).

Independent claim 16 is, and thus, dependent claims 17-19 are also, amended by the foregoing amendments. As a result, claims 16-19 as amended each requires the added steps of: recording or inputting a sound data; and, storing the sound data in a flash memory of the camera for selection by the user as a start sound of the camera. Applicants submit that these limitations added by the present amendments have already been considered by the Examiner in connection with similar limitations appeared in claims 1-3, 6-7, 9-14 and 20-21 previously presented. Therefore, Applicants respectfully submit that no new search or consideration of new issue is necessary in connection with the added limitations.

As claims 16-19 are amended by the amendments, this rejection is now moot. Reconsideration is respectfully requested in view of the amendments and following remarks.

As specifically recited in independent claim 16, claims 16-19 each requires among other limitations: (i) recording or inputting a sound data; (ii) storing the sound data in a flash memory of the camera for selection by the user as a start sound of the camera; (iii) said setting-up the start information signal being performed through execution of a start information setting algorithm with a microcontroller of the camera and without ever connecting the camera to an external computer for selecting, configuring, customizing or setting the start information signal by the external computer; (iv) said setting-up the start information signal being performed by

selecting desirable start information from a group consisting of the sound data recorded or inputted by the user, image data stored in the memory medium, the sound data stored in the flash memory of the camera, and image data stored in the flash memory.

As detailed below, Applicants respectfully submit that Prabhu et al. fails to disclose or teach, among others, the above-identified limitations (ii)-(iv) of claims 16-19.

First, Prabhu et al. fails to disclose or teach the limitation (ii) of storing the sound data in a flash memory of the camera for selection by the user as a start sound of the camera. This fact is acknowledged by the Examiner. See Office Action, page 8, first paragraph.

Moreover, Prabhu et al. further fails to disclose or teach the limitation (iii) that said setting-up of the start information signal is performed through execution of a start information setting algorithm with a microcontroller of the camera and without ever connecting the camera to an external computer for selecting, configuring, customizing or setting the start information signal by the external computer. To the contrary, Prabhu et al. merely discloses a method for customizing a digital camera for at least one particular user with an external computer having a specific application program for downloading, customizing and setting up the firmware components of the camera.

Furthermore, Prabhu et al. further fails to disclose or teach the limitation (iv) of setting up of a start information signal with a user input unit coupled with a menu option for setting the start information signal, said setting-up the start information signal being performed by selecting desirable start information from a group consisting of the sound data recorded or inputted by the user, image data stored in the memory

medium, the sound data stored in a flash memory of the camera, and image data stored in the flash memory.

In this regard, the Examiner alleges that Prabhu et al. discloses this feature as column 14, lines 22-29, suggests "the user selects their name or start information signal at startup by selecting from the menu and the processor selects the desired GUI image to display from the Flash EPROM 28".

Applicants, however, respectfully traverse. Prabhu et al., column 14, lines 22-29, recites: "When the digital camera 10 is powered on, a list of users is displayed on the image display 22 and the user selects their name using the camera user interface 24. In response to this user input, the processor 18 uses the appropriate firmware components or firmware settings stored in the Flash EPROM 28 to provide the customized camera GUI and feature set for that particular user." (Emphasis added.) This disclosure suggests mere selection of one user's name among multiple users, Thus, it is not related to the claimed feature of setting a start information signal (which signal is to be reproduced at startup of the camera) with a user input unit coupled with a menu option, and particularly, by selecting desirable start information from a group consisting of a sound data recorded or inputted by the user, image data stored in the memory medium, sound data stored in a flash memory of the camera, and image data stored in the flash memory.

In order to reject a claim in view of prior art, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). To establish a prima facie case of obviousness under 35 U.S.C. 103, the prior art reference must teach or suggest all the claim limitations. See MPEP 2143 et seq. Applicant submits that Prabhu et al. (and other references of record) fail to disclose or teach all the claim limitations

(all words in the claims) of claims 16-19, in particular, the above-identified limitations (ii)-(iv).

Accordingly, in view of the foregoing, Prabhu et al. fails to disclose or teach, among others, the above-identified limitations of the invention as claimed in claims 16-19. Therefore, claims 16-19 are patentable over the references of record under either 35 U.S.C. 102(e) or 35 U.S.C. 103(a).

Conclusion

In view of the above remarks, Applicants submit that all of the pending claims of the present application, namely Claims 1-3, 6-7, 9-14 and 16-21, are patentable over the references of record and in condition for allowance. Favorable reconsideration and early notice to that effect is earnestly solicited.

Respectfully submitted,



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Hyun Jong Park, Registration No. 59,093
Attorney for Applicants
TUCHMAN & PARK LLC
41 White Birch Road
Redding, CT 06896-2209
(203) 702-7102